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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Leo Stoller d/b/a Central Mfg.
v.
York International Corporation.

Opposition No. 121,420
to Application Serial No. 75/687,921

Leo Stoller, pro se.

John H. Weber of Baker & Hostetler LLP for York
International Corporation.

Before Quinn, Hairston, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On April 22, 1999, York International Corporation
(applicant) applied to register the mark STEALTH in typed
form on the Principal Register for goods ultimately
identified as "residential and commercial air

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conditioners, heat pumps, and furnaces" in International Class 11.¹

On December 8, 2000, Leo Stoller d/b/a Central Mfg. (opposer) opposed the registration of applicant's mark alleging that applicant's mark was confusingly similar under Section 2(d) of the Trademark Act to numerous trademark registrations it owned. 15 U.S.C. § 1052(d).² Opposer also asserts that it "has priority of use of the mark STEALTH on similar goods namely, fans, air coolers and air conditioners, which are sold or would be sold in similar channels of trade and to the identical customers that applicant's goods are sold in, since at least as early as 1985." Notice of Opposition, p. 3.³

¹ Serial No. 75/687,921. The application is based on an allegation of a bona fide intention to use the mark in commerce.

² Opposer asserts that it "holds rights in the following STEALTH trademark registrations." The notice of opposition (p. 1) lists Registration Nos. 1,332,378; 1,434,642; 1,717,010; 1,867,087; 1,947,145; 2,024,889; 2,025,156; 2,007,348; 2,074,780; 2,227,069; 2,325,053; and 2,325,054. On page 3 of its notice of opposition, opposer refers to many of these registrations and adds No. 1,766,806. Attached to its notice was another list of registrations that also referred to additional Registration Nos. 1,330,467 and 2,269,113. Opposer also refers to numerous trademark applications in its notice of opposition. While applicant indicates that copies were attached to its notice (p. 1), no copies were in fact attached. See also Answer, p. 1.

³ Opposer filed a first and a second amended notice of opposition. Opposer withdrew the first amended notice in his paper dated September 4, 2001. On May 15, 2002, the Board entered an order sanctioning opposer by refusing to consider its second amended notice and prohibited opposer from filing any additional amended notices of opposition. Order at 7. To the

Applicant denied the salient allegations of the notice of opposition.

Motions

We begin our discussion in this case by disposing of the numerous motions that are currently pending.

On March 31, 2003, opposer filed a "Motion for Reconsideration of Board order Dated March 10, 2003 and Motion for [Dis]Qualification of Ms. Angela Lykos." Opposer seeks reconsideration of the Board's order that determined that applicant's request for sanctions was not a motion under Rule 11 but rather a motion for sanctions under the Board's inherent authority. The Board has noted that "[w]hile Fed. R. Civ. P. 11 covers some of the conduct at issue in this case, it does not adequately address all, or even the most egregious, conduct... When the described conduct does not squarely fall within the reach of Fed. R. Civ. P. 11, a court may invoke its inherent authority." Carrini Inc. v. Carla Carini S.R.L., 57 USPQ2d 1067, 1071 (TTAB 2000). See also Schlaifer Nance & Co. v. Estate of Warhol, 194 F.3d 323, 335 (2d Cir. 1999) ("Although the Estate's motion focused chiefly on Rule 11 as the basis for sanctions, the motion

extent that opposer is seeking similar relief in its brief that it entitles "Trial Brief and Request for Leave to Amend the

also invoked and set forth the standards for sanctions under the District Court's inherent power"). The TBMP contemplates that non-discovery motions for sanctions other than under Rule 11 are permitted. TBMP § 529.02. Opposer's request for reconsideration is therefore denied.⁴

On April 21, 2003, opposer filed a "Motion for Rule 11 Sanctions." In addition to the discussion above, we also deny opposer's motion for sanctions because opposer has not established that applicant's request for sanctions was frivolous.

On April 24, 2003, opposer filed a request for oral argument. Opposer's reply brief was filed on January 14, 2003. A request for oral hearing was due "not later than ten days after the due date for the filing of the last reply brief in the proceeding." 37 CFR § 2.129(a). The fact that applicant and opposer had filed motions for sanctions did not stay the time for filing a request for oral hearing. Therefore, opposer's request for oral hearing is denied as untimely.

Complaint to Conform to the Evidence," such request for relief is denied.

⁴ It has been held that "the standard for the imposition of sanctions using the court's inherent powers is extremely high. The court must find that the 'very temple of justice has been defiled' by the party's conduct." Goldin v. Bartholow, 166 F.3d

Lastly, we are authorized to report that the Chief Administrative Trademark Judge has denied opposer's motion to disqualify Ms. Lykos.

The Record

The record consists of the file of the involved application, the testimonial deposition of opposer with exhibits, the testimonial deposition of Raymond Webber, a customer of opposer, with exhibits, and opposer's notice of reliance on photocopies of status and title copies⁵ of Registration Nos. 2,325,054; 2,325,053; 2,269,113; 2,227,069; 2,074,780; 2,025,156; 2,024,889; 2,007,348; 1,947,145; 1,867,087; 1,434,642; and 1,332,378, and other papers related to opposer's business.

710, 722-23 (5th Cir. 1999), quoting, Boland Marine & Mfg. v. Rihner, 41 F.3d 997, 1005 (5th Cir. 1995).

⁵ Opposer is relying on numerous trademark registrations in this case. He has provided various types of copies of these registrations in his notice of reliance and in his deposition. These copies include photocopies of status and title copies, copies of printouts from USPTO's electronic databases, and copies of what appear to be the original trademark registration. To make matters more confusing, there are times when assignment documents are sandwiched between the status and title certification and the registration photocopies. Because applicant has not objected to these documents and because we ultimately have determined that there is no likelihood of confusion regarding the referenced registrations, we will discuss them but we remind opposer that, in the future, the proper method of making these registrations of record is set out in 37 CFR § 2.122(d) and TBMP § 703.02(d).

Applicant has not submitted any evidence during its testimony period.⁶

Priority

Priority is not an issue here to the extent that the opposition is based on ownership of numerous registrations for STEALTH marks. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). However, opposer is also relying on common law rights. In that case, "the decision as to priority is made in accordance with the preponderance of the evidence." Hydro-Dynamics Inc. v. George Putnam & Company Inc., 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). In this case, applicant has introduced no evidence of the use of its mark so the earliest date it can rely on is its application's filing date (April 22, 1999). Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542, 1544 (TTAB 1991) ("[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an

⁶ Applicant has filed a trial brief but it raises only two points. The first point concerns whether opposer will be damaged by applicant's trademark and the second is a request to sanction opposer by dismissing the opposition.

opposition brought by a third party asserting common law rights").

Opposer, on the other hand, has submitted evidence in the form of a deposition of Raymond Webber to establish its common law rights to the mark STEALTH on air conditioners. Mr. Webber identified himself as "a customer of Leo Stoller's Company Stealth and a purchaser of Stealth brand cooling equipment, fans and air conditioners." Webber dep. at 4. Mr. Webber agreed that he purchased STEALTH air conditioners.

A. It's a portable Stealth air conditioner.

Q. And did you in fact purchase from the opposer such a device?

A. Yes.

Q. And when was the first year you bought a Stealth portable air conditioner from the opposer, if you recall?

A. I believe it was 1987.

Q. Are you sure it was 1987?

A. Relatively sure, yes, sir.

Q. Well, could it have been 1980 - it was in the 80's?

A. Yes.

Q. You're sure of that?

A. Yes, late 80's.

Q. Late 80's, that you're sure of?

A. Yes, sir.

Webber dep. 3-4.⁷

Webber also testified that he purchased another Stealth air conditioner in 1993 and again in 1999. Webber dep. at 6. The witness identified a STEALTH air conditioner he bought from an advertisement with a 1993 copyright date. Webber dep. at 6. Opposer also included other evidence of continuing sales of STEALTH air conditioners and fans. When we view the evidence as a whole, we find that opposer has established prior use of its mark STEALTH on air conditioners. See West Florida Seafood, Inc. v. Jet

Restaurants Inc., 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994).

Likelihood of Confusion

Regarding the issue of likelihood of confusion, there are two potential allegations of confusion. The first involves the issue of likelihood of confusion between applicant's STEALTH mark for residential and commercial air conditioners, heat pumps and furnaces and

⁷ Applicant's counsel did not attend this deposition.

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opposer's numerous registrations for the word STEALTH for a variety of products and services. We begin our discussion of this issue of likelihood of confusion by considering the factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Applicant's mark and most of opposer's marks are for the identical word STEALTH in typed form. Regarding the goods and services, applicant's goods are air conditioners, heat pumps and furnaces. A sampling of the goods and services in opposer's registrations is set out below: alloys for use in sporting goods and transportation and window locks (No. 2,025,156), comic books (No. 2,007,348), financial planning (No. 2,227,069), radar detectors (No. 2,074,780), lawn

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sprinklers (No. 2,024,889), motorcycles (No. 1,434,642), and tennis rackets (No. 1,332,378). Opposer argues that it "has established that it has priority of use of the STEALTH mark on a broad range of competitive, related products which are listed in Opposer's 26 STEALTH trademark Registrations." Brief at 8. Opposer's general allegations of confusion based on its cited registrations are not persuasive. The goods in these registrations are markedly different from applicant's air conditioners, heat pumps, and furnaces. While applicant's goods and many of opposer's goods and services could be purchased by ordinary consumers, there is certainly no per se rule that all consumer items are related. See, e.g., Federated Foods, Inc., d.b.a. Hy-Top Products Division v. Fort Howard Paper Company, 544 F.2d 1098 192 USPQ 24, 29 (CCPA 1976) ("A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the consumer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on any goods so displayed"). Indeed, even if the goods are sold

in the same store, this fact does not establish that the goods are closely related.

It is common knowledge that there are sold in many hardware, grocery, variety and drug stores an almost unlimited variety of goods including tools, housewares, electrical appliances, seed, fertilizer, furniture and toys. The public being well aware of the diversity of goods to be found in such stores is not going to believe that all of those goods could originate with a single source.

Irwin Auger Bit Co. v. Irwin Corp., 134 USPQ 37, 39 (TTAB 1962).

While opposer alleges that it owns numerous registrations⁸ for a variety of goods and services, the question here is whether these goods and services in those registrations are related to applicant's air conditioners, heat pumps, and furnaces. Opposer argues (Brief at 17):

The Parties' Goods Are Related
Opposer's goods are fans, air coolers and air conditioners and the goods listed in its 26 STEALTH

⁸ Applicant challenges opposer's ownership of these registrations. Brief at 1 ("Opposer has not proved that he is the owner of the pleaded trademarks"). Indeed, most of the registrations are identified as belonging to Central Mfg. Co. or S industries, Inc. Applicant responded by filing a notice of privity in which it is stated that "Leo Stoller d/b/a Central Mfg. Co. was assigned the right to litigate on behalf of Central Mfg. Co. dba Central Mfg., Inc. to oppose, petition to cancel and/or sue for damages by reason of past, present, and future infringement of the mark STEALTH." Notice of Privity date March 13, 2001. Inasmuch as it is apparent to us that there is no likelihood of confusion between the goods and services in the identified registrations and applicant's mark used on the identified goods, we need not reach the issue of whether these registrations have been properly assigned to opposer.

Trademark Registrations... The Applicant's goods are air conditioners.

Opposer has not provided any specific basis for determining that the goods and services in opposer's registrations and applicant's air conditioners, heat pumps, and furnaces are related, nor are we aware of any relationship. Therefore, to the extent that opposer is alleging a likelihood of confusion between the referenced registrations and applicant's mark when used on the identified goods and services in the application and opposer's registrations, we hold that there is no likelihood of confusion.⁹

We now come to opposer's allegation that applicant's mark should be refused registration because opposer has used the mark STEALTH on air conditioners prior to the filing date of the application for air conditioners, heat pumps, and furnaces. Here, as discussed earlier, opposer has established that it has used the mark STEALTH on air conditioners before applicant. Opposer's witness has identified an advertisement dating back to 1993 (Webber

⁹ "[I]t has been held that ownership of a large number of registrations for marks containing a common prefix or suffix is insufficient, per se, to establish recognition of a 'family' of marks." Consolidated Food Corp. v. Sherwood Medical Industries, Inc., 177 USPQ 279, 282 (TTAB 1973). Even if opposer owns numerous registrations for a variety of unrelated goods and services, this fact does not establish that it has a "family" of

dep. at 6, Ex. 19) showing that opposer has used the mark STEALTH in a simple block style on air conditioners.

Applicant's and opposer's marks are virtually identical.

Even if there

was a difference in the display of the marks, inasmuch as applicant's drawing displays the mark in typed form, any difference would not be legally significant. Squirtco v.

Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir.

1983). Since applicant's identified goods include air conditioners and opposer has demonstrated that it has used

the mark on "portable air conditioners," we find that the goods are identical. When identical or even virtually identical goods are used on identical goods there is, of course, a likelihood of confusion. To the extent that there is any doubt on this subject, opposer has introduced evidence of actual confusion in the form of testimony from his witness.

A. Right. For a number of years I was a residential heating sales consultant both for residential and commercial sales employed by several different companies here in northern Illinois. I was very successful. I sold

marks (Brief at 3-4) that would prevent the registration of

numerous products. I sold train carrier [Trane Carrier] Frigidare products.

Q. And isn't it a fact that in the course of your sales of these train Frigidaire carrier products that customers would mention the brand Stealth, that they wanted a Stealth air conditioner?

A. On half a dozen different occasions, yes, it was brought up.

Q. And when your customers brought up the fact that they wanted to purchase a Stealth air conditioner, who did you think the Stealth air conditioner they wanted to purchase came from?

A. I thought it was from Leo Stoller, the gentleman I had met from Stealth Corporation.

Q. And when you found out that the Stealth air conditioner that they wanted was a York brand, were you confused?

A. It presented a series of confusion. I called you up and I finally got ahold of you on the phone and brought. This to your attention, what had been stated to me by a couple of different people, that I had customers and I had to get back to them the next day and - I guess you

applicant's mark for air conditioners, heat pumps and furnaces.

weren't even aware of it at that time or I don't know if you were or not, but I continued to do business with you so that was supply the customer with the product from you [sic].

Webber dep. at 7-8.¹⁰

This evidence of actual confusion, of course, supports opposer's argument that confusion is likely. Based on all the evidence of record we conclude that there is a likelihood of confusion between applicant's STEALTH mark used on air conditioners and opposer's STEALTH mark also used on air conditioners.

STANDING

Applicant's main argument is that the opposition should be dismissed because "[a]ll of the STEALTH trademarks (and related USPTO registrations), relied upon by Opposer, are in the name of Central Mfg. Co." Brief at 2. Applicant's motion is in the nature of a motion to dismiss for lack of standing because applicant does not have an interest beyond that of the general public in order to initiate this proceeding. We have already noted

¹⁰ Interestingly, the application is based on an intention to use the mark in commerce so it is not clear how the customer would have been aware of the York brand air conditioners. However, applicant has not challenged this testimony, and actual use is not necessarily inconsistent with an intent-to-use application. In re Paul Wurth S.A., 21 USPQ2d 1631, 1633 (Comm'r Pat. 1991).

that we do not have to reach this issue regarding the trademark registrations. With regard to the common law rights in the mark STEALTH for air conditioners, we find that applicant has not demonstrated that opposer does not own the marks or, even if he does not, that he does not have standing to oppose the registration of applicant's mark. We have been cautioned to avoid making arbitrary distinctions in cases such as this.

Moreover, to the extent that the TTAB's decision suggests that West may be attempting to claim prior use for use that it cannot truthfully credit to itself, such a suggestion is nothing more than an unjustifiable refusal to recognize the connection between West Florida Seafood (the corporate name), "FAST EDDIE'S PLACE" (the trade name), and Edwin or E. Porter (the company's president). The TTAB erred in ignoring the rather obvious connection between these corporate, business, and personal "alter egos" operating as "FAST EDDIE'S." These interrelationships were specifically set forth both in West's petition to cancel Jet's registration as well as in West's own application to register the "FAST EDDIE'S" mark, and given the evidence submitted, there is simply no basis in the record to question that the asserted interrelationships exist.

West Florida Seafood, 31 USPQ2d at 1664.

"It is to be noted that the instant proceeding is an opposition and that accordingly the issue is not whether appellee (the opposer) owns the mark in issue or is entitled to register it, but whether it is likely that he would be damaged if a registration of the mark were granted to appellant." Wilson v. Delaunay, 245 F.2d 877,

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114 USPQ 339, 341 (CCPA 1957). Opposer is identified with the STEALTH mark and opposer is involved with licensing the mark. See Webber dep. at 4 ("I am an Illinois resident and a customer of Leo Stoller's Company Stealth") and at 8 ("[W]ho did you think the Stealth air conditioner they wanted to purchase came from? A. I thought it was from Leo Stoller"). See also Stoller dep. at 5 ("[O]pposer has aggressively licensed its mark Stealth on a broad range of products throughout the United States and the world"). Clearly, opposer has "an interest in the outcome beyond that of the public in general and has standing." Books on Tape Inc. v. The Booktape Corp., 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987).

SGA's claims of priority of use, coupled with its pleading of likelihood of confusion, constitute a legally sufficient pleading of SGA's claim that it has a real interest in the proceeding and, therefore, standing to pursue the opposition. See Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). This is so even if SGA's use of the two pleaded marks is as a licensee or distributor for WSC, for a plaintiff may have standing in a case brought under Section 2(d) of the Trademark Act even if it does not claim ownership of the assertedly similar mark, or the right to control its use. See J.L. Prescott Co. v. Blue Cross Laboratories (Inc.), 216 USPQ 1127 (TTAB 1982) (opposer that had assigned mark and obtained exclusive license from assignee held to have standing); See also, Universal Oil Products Co. v. Rexall Drug and Chemical Co., 463 F.2d 1122, 174 USPQ 458 (CCPA 1972); BRT Holdings Inc. v. Homeway Inc., 4 USPQ2d 1952 (TTAB 1987); Chemical New York

Corp. v. Conmar Form Systems, Inc., 1 USPQ2d 1139 (TTAB 1986); and Yasutomo & Co. v. Commercial Ball Pen Co., Inc., 184 USPQ 60 (TTAB 1974).

William & Scott Co. v. Earl's Restaurants Ltd., 30 USPQ2d 1870, 1873 n.2 (TTAB 1994).

Opposer was not required to prove he owned the common law mark in order to participate in this proceeding. He has shown that he has an interest beyond that of the general public and, therefore, we deny applicant's request that we dismiss this proceeding with prejudice on this ground.

Applicant's Request for Sanctions

At the end of its trial brief, "Applicant requests that the opposition be dismissed with prejudice as a sanction against Opposer for entering doctored evidence. Applicant *requests the Board to take judicial notice of the patently doctored exhibits to Stoller deposition transcript, namely: Exhibits 9, 13-14 and 19. Stoller Dep. Tr.; Exs. 9, 13-14 and 19.*" Applicant's Br. at 3-4 (Emphasis added).¹¹ Applicant then cites numerous cases where the conduct of opposer, his attorneys, or companies associated with him have been criticized and/or sanctioned by courts. Applicant concludes by stating that "[o]pposer, apparently, learned his lesson and is

now falsely trying to prove that he uses the trademark STEALTH in association with directly competing products. Hopefully, the Board will teach Opposer that he learned the wrong lesson by dismissing this opposition as a sanction." Applicant's Br. at 6.

We find applicant's request for sanctions to be somewhat bizarre. Applicant, of course, as the defendant in this proceeding, was not required to present evidence or attend depositions. Applicant took full advantage of this freedom and did not attend the Stoller or Webber depositions. Applicant filed no objection to these depositions until the request for dismissal of the opposition appeared at the end of its trial brief. Now, applicant requests that we take judicial notice that opposer's evidence is "doctored." It is strange that a party represented by counsel would request sanctions without providing any specific hint or argument as to what in the exhibits is "doctored" or how it was "doctored." Regardless of whether applicant's opponent has been sanctioned or disciplined in other proceedings, it does not relieve applicant and its counsel of providing some notice to the opposing party and this board as to what conduct applicant believes is

¹¹ We note that Exhibit 19 is not attached to the Stoller

sanctionable. See, e.g. Fed. R. Civ. P. 11(c)(1)(A) (emphasis added) ("A motion for sanctions under this rule shall be made separately from other motions or requests and *shall describe the specific conduct alleged to violate* subdivision (b)"). The fact that applicant requests sanctions under the Board's inherent authority rather than Rule 11 does not relieve applicant of its obligation as well as the professional courtesy to notify the opposing party of what the objectionable conduct is alleged to consist. Applicant's counsel has the obligation to develop the facts to support its conclusion that the evidence has been doctored. We are at a loss to understand how we could find that "there is no reasonable dispute" that opposer's evidence is doctored. TBMP § 712.01 ("Kind of Fact Which May be Judicially Noticed"). Therefore, we deny applicant's request that the opposition be dismissed as a sanction.

Decision: The opposition is sustained and registration to applicant of its mark STEALTH is refused.

deposition but to the Webber deposition transcript.